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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

TRAN, LOUIS B

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/680,817

Applicant(s)

PONTAN ET AL. *cm*

Examiner

Louis B Tran

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 28, 23-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment, Paper No. 13, received on 07/15/2003.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 28, 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Guglielmi (1,575,263).

With respect to claims 28, Guglielmi anticipates creating a character effigy comprising the steps of providing an item which is flexible and substantially planar, defining an unobstrusive character feature at a location of the item representative of only head characteristics, said feature having no significant context of a complete character effigy when said item is in a planar configuration and manipulating the flexible and substantially fully planar item between a generally planar configuration and a non-planar configuration, wherein when the item is in the generally planar configuration, it serves a practical function and when it is in the non-planar configuration, it gives context to a complete character effigy by simulating the body of the character effigy with the character feature positioned appropriately with respect to the body formed by the item to simulate the character's head as discussed in Guglielmi on page 1 column 2, lines 103- page 2, column 1, lines 1-30 and seen in Figures 1 and 2.

With respect to claim 23, Guglielmi anticipates providing an item having first and second surfaces and at least first, second and third edges, and wherein said character feature is defined on said first surface as in Figure 2.

With respect to claim 24, Guglielmi anticipates wherein the step of manipulating is accomplished by folding said item to simulate the body of the character effigy as in column 1, page 2, lines 20-30.

With respect to claim 25, Guglielmi anticipates the step of manipulating being accomplished by rolling said item to simulate the body of the character effigy as seen in Figure 1.

With respect to claim 26, Guglielmi anticipates wherein the step of manipulating is accomplished by folding and rolling said item to simulate the body of the character effigy as seen in Figure 1 and described in column 1, page 2, lines 20-30.

4. Claims 28, 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Ming (5,172,440).

With respect to claims 28, Ming anticipates creating a character effigy comprising the steps of providing an item which is flexible and substantially planar, defining an unobtrusive character feature at a location of the item representative of only head characteristics 31 said feature having no significant context of a complete character effigy when said item is in a planar configuration and manipulating the flexible and substantially fully planar item between a generally planar configuration and a non-planar configuration (open bag and closed bag positions), wherein when the item is in the generally planar configuration, it serves a practical function and when it is in the non-

planar configuration, it gives context to a complete character effigy by simulating the body of the character effigy with the character feature positioned appropriately with respect to the body formed by the item to simulate the character's head as discussed in Ming in column 2, lines 42-57 seen in Figures 8 and 9.

With respect to claim 23, Ming anticipates providing an item having first and second surfaces and at least first, second and third edges, and wherein said character feature is defined on said first surface as in Figure 8.

With respect to claim 24, Ming anticipates wherein the step of manipulating is accomplished by folding said item to simulate the body of the character effigy as in column 2, lines 42-57.

With respect to claim 25, Ming anticipates the step of manipulating being accomplished by rolling said item to simulate the body of the character effigy as seen in Figures 8 and 9.

With respect to claim 26, Ming anticipates wherein the step of manipulating is accomplished by folding and rolling said item to simulate the body of the character effigy as in column 2, lines 42-57.

Conclusion

5. Applicant's remarks have been fully considered but are deemed non-persuasive. Applicant contends that the folding of Guglielmi does nothing to complete the character effigy. Examiner contends that Guglielmi does complete the character effigy by simulating the body as claimed.

Furthermore, applicant contends that Ming teaches away from the method defined by claim 28. However, Examiner contends that Ming still teaches the method as claimed. The newly amended claim recites, "said feature having no significant context of a complete character effigy when said item is in a planar configuration." Ming could be described to be in "a complete character effigy" when it is in the rolled configuration of Figure 9.

For the reasons above, the grounds of rejection are deemed proper.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis B Tran whose telephone number is 703-305-0611. The examiner can normally be reached on 8AM-6PM Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

lbt

A handwritten signature in black ink, appearing to read 'Rinaldi I. Rada', with a long horizontal flourish extending to the right.

Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700